REMARKS

Claims 1-21 are pending in the application. Applicant requests an Advisory Action.

35 U.S.C. § 103 Rejections

Governing Criteria

For rejections under 35 U.S.C. § 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a prima facie case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al. (550 U.S. 127 S. Ct. 1727 (2007)*) to be "expansive and flexible" and "functional." However, the standard is not controlling, rather, the various noted factors only "can" or "might" be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

> "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill….[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need "to guard against slipping into the use of hindsight," acknowledged the following principles:

> [r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.
>
> [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

> One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

> a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.,* 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.,* 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

> [o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Discussion of Rejections

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Greer et al (U.S. Patent No. 6,247,048) in view of Bennett (U.S. Patent No. 6,122,670) and Solymar (U.S. Patent No. 6,244,758). Applicant respectfully traverses this rejection.

Greer does not disclose each and every element of the claims. In general, Greer discloses a method of translation, that is, taking data represented in one character set and translating (transcoding) the data so that it is represented by another character set. See col. 1, lines 40-54. Greer does not contemplate adapting a communication protocol so that communication can be optimized and/or customized to the transport mechanism used as claimed. The Examiner states that "said host computer system recognizing said one transport mechanism used in step a) by an adaptation means" is taught by the following:

> At step 450, the character set transcoder will test to see if the character set used in the response is the same character set used by the mobile computer device. If the character set is the same, then no transcoding is needed. However, if the character sets do no match, then the character set transcoder 345 transcodes the response from the Internet server into the character set used by the mobile computing device at 480. The character set used by the mobile computing device was set during the session creation or specified in the GET request. Col. 7, lines 10-19.

However, character set transcoding is not analogous to recognizing a transport mechanism. A transport mechanism is, for example, "a serial cradle, networked cradle, modem, cellular wireless, radio frequency, infrared, Internet, etc." (Specification, p. 6, lines 8-10). Nothing in the passage cited by the Examiner teaches or suggests this claim limitation, i.e., there is no transport mechanism.

Greer also does not teach or suggest "determining a communication protocol from a plurality of possible communication protocols based on recognition of said one transport mechanism." The Examiner states the following teaches this element:

> In the embodiment of FIG. 1, the communication protocol between the mobile device 106 and the proxy server 114 via the airnet 102 is the Handheld Device Transport Protocol (HDTP) which preferably runs on User Datagram Protocol (UDP). The HDTP controls the connection of a small Web browser in the mobile device 106 to the proxy server 114. In the embodiment of FIG. 1, the browser in the mobile device 106 may be a Handheld Device Markup Language (HDML) browser. The Handheld Device Markup Language (HDML) is similar to HTML in that it is a tag based document language and comprises a set of commands or

> statements that specify how information is to be displayed on a display device. HDML is a specific markup language designed to specify in a "card" how information should be displayed on a small display screen 116 of the mobile device 106. Col. 4, lines 18-33.

However, the above-mentioned protocols are fixed. The proxy server makes no determination of any protocol. Furthermore, Greer cannot make a determination based on recognition of a transport mechanism because, as stated above, Greer does not contemplate recognizing transport mechanisms.

Bennett does not cure Greer's deficiencies. Bennett does not teach or suggest "determining comprises indexing a table with said one transport mechanism recognized in step b) to determine at least one parameter in the communication protocol, and wherein said table comprises parameters that are designed to improve communication based on the transport mechanism." The Examiner cites the following as teaching this element:

> Thus, protocol logic subsystem 45 verifies that the IP header checksum result is correct, and verifies that the TCP segment checksum is correct, before sending the datagram to IP process 96, via bus 43, protocol logic 45, bus 49, i900 bridge 407, bus 47, bus interface 37, and PCI bus 30. If either the IP header checksum or the TCP segment checksum results are incorrect, protocol logic subsystem 45 discards the datagram (does not send the datagram to PCI bus 30). Col. 6, lines 34-43).

However, this disclosure reveals only that the protocol logic subsystem determines whether a datagram is accepted or not. Verifying a checksum in an IP header or TCP segment does nothing to improve communication based on the transport mechanism as claimed. Header checksum verification merely determines data corruption of a particular data packet. In fact, header checksums are not parameters of a communication protocol at all; rather they merely are characteristics of a data packet (independent of a protocol).

Communication protocol parameters as disclosed by Applicant include, but are not limited to "data compression, data encryption, communication rate, maximum character length allowed to be transmitted, user authentication, and data set limitation." (Specification, p. 18, lines 2-4). Upon consultation of an indexing table (See Specification, Figure 14), certain parameters are determined to use for the particular transport mechanism recognized as claimed. As such, the Examiner's citation does not disclose determining any communication protocol

much less indexing a table to determine a parameter in the communication protocol with a view to improve communication as claimed.

Solymar does not cure Greer or Bennett's deficiencies. Solymar does not teach or suggest "said host computer system communicating information to said peripheral computer system based on said communication protocol determined at step c)" as suggested by the Examiner. Solymar is a system for "retrieving lost or stolen electronic devices." (Col. 2, lines 16). Solymar does not determine a communication protocol. Moreover, the citation provided by the Examiner reveals that a client computer is connected to the Internet through a private network or alternatively a SLIP link. This disclosure, indeed Solymar itself, has little if anything to do with the subject matter claimed.

As such, Greer, Bennett and Solymar, alone or in combination, do not teach or suggest every element of the claims. Also, Applicant submits that any combination is obtained solely through the benefit of hindsight. The Examiner has failed to show reasoning why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art. Greer discloses transcoding characters sets from one format to another. Bennett discloses sending and receiving data with a reliable communication protocol. Solymar discloses locating and monitoring electronic devices utilizing a security system secretly embedded in a computer. None of these references confront a skilled artisan with the same problem as the inventor, that is, adapting data synchronization and transport between a host and a peripheral computer system. The subject matter of these references is not in the same field of endeavor such that they are combinable. Thus, any combination of these three quite disparate disclosures comes from Applicant's disclosure of the claimed invention.

Accordingly, claims 1-21 are patentable over any combination of Greer, Bennett and Solymar. As the claims are in condition for allowance, withdrawal of the rejection of claims 1-21 is requested and a notice of allowance is solicited. Additionally, Applicant requests an Advisory Action.

The Examiner is invited to contact the undersigned to discuss any issues regarding this case.

Respectfully submitted,

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